

### **REMARKS**

This responds to the Office Action mailed on October 21, 2004, and the references cited therewith.

Claims 1, 20, 38, 42, 44, and 46 are amended; as a result, claims 1-7, 10-20, 38-45, and 46-49 are now pending in this application.

### **Amendment of Claims**

Claims 1, 38, 42, 44 and 46 have been amended to clarify that a set of queries exist at the server before receiving information about a medical procedure.

Claims 1 and 46 have been amended to clarify that the method is performed at a server.

Claim 20 has been amended to depend on claim 1 instead of claim 8.

### ***Response to Claim Rejections – 35 USC § 112***

Claim 20 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 20 recites a claim that has been deleted. Responsive to this rejection the Applicant has amended claim 20 to depend upon independent claim 1.

### ***Response to Claim Rejections – 35 USC § 101***

Claims 1-7, 10-15 and 20 was rejected under 35 U.S.C. § 101 because the claims are allegedly directed towards subject matter that is not within the technological arts. Specifically, the Final Office Action states, “[t]he deficiencies in the present claim language may be overcome by expressly stating in the body of the claims the use of technology, such as a computer processor and/or a computer database”.

Claim 1 includes the limitations that the method is performed at a server and ::

performing a query function to retrieve from at least one computer database a list of data sources

Claim 1 requires a computer database from which to retrieve a list of data sources. It follows that claim 1 is within a "technological art" because claim 1 recites a computer database operation. Consequently, claim 1 should not be rejected for the reason that it does not disclose any manipulation by a technology or dependence on the technology because claim 1 requires the computer database to perform a computer-implemented operation.

In summary, claim 1 is not directed towards subject matter that is not within the technological arts as required to support a rejection of this claim under 35 U.S.C. § 101.

As dependent claims are deemed to include all limitations of claims from which they depend, the rejection of claims 2-7, 10-15 and 20 under 35 U.S.C. 101 are also addressed by the above remarks.

In summary Applicant respectfully submits that claims 1-7, 10-15 and 20 should not be rejected under 35 U.S.C. § 101 for the reason that claims 1-7, 10-15 and 20, as amended, are directed towards statutory subject matter.

### ***Response to Claim Rejections – 35 USC § 102***

Claims 1, 6-7, 10-15, 17-20, and 38-47 was rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,263,330 (hereinafter Bessette).

Applicant respectfully submits that claim 1 should not be rejected under 35 U.S.C. § 102(e) for the reason that Bessette does not disclose each and every limitation of the claim 1 of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Claim 1, as amended, includes the following limitation:

at a server....selecting a set of preexisting queries that correspond to the received information about the medical procedure.

The Office Action in rejecting claim 1 contends that the above limitation is anticipated by the following disclosures in Bessette:

Next, the server waits for a request from any of the logged on clients...

At step 816, the processor must determine the search parameters specified by the request. These parameters consist in a patient's identifier and/or a list of other qualifiers (for instance a particular treatment, medical condition, age group, sex, etc). Control is passed to the DBMS logic at step 818, at which point the search is performed on the NDSMR database.

Bessette, Col. 11, lines 2 – 31 (first quote).

In short, the NDSMR record is data structure that contains two types of elements, namely a collection of medical data elements about the individual and one or more pointers ...these pointers adopt the URL (Universal Resource Locator) addressing system...

Bessette, Col. 13, lines 23-26 (second quote).

FIG. 9 illustrates an example of a procedure to be followed by medical facility archivists in order to update the NDSMRs. ... At step 908, the NDSMR is downloaded to the archivist's workstation, at which point the archivist is capable of modifying and updating certain sections of the data contained in the NDSMR,

Bessette, Col. 14, line 38 – 58 (third quote).

The first quote describes a server that receives a request that includes search parameters. The search parameters may include a patient's identifier and/or a list of other qualifiers (e.g., a treatment, medical condition, age group, sex, etc). The server is further described as performing a search on a Network Distributed Shared Medical Record (NDSMR) database.

The second quote describes an NDMSR record that contains URLs. The NDMSR record may be downloaded to a client station to enable the client station to link to the remotely stored files (Abstract).

The third quote describes a procedure that is followed by a medical facility archivist. The archivist may modify and update certain sections of data contained by the NDSMR.

Claim 1 requires selecting a set of preexisting queries at a server that corresponds to received information about a medical procedure. For example, in one embodiment, the results of a blood test may correspond to the following set of preexisting queries that may be selected at a server:

“http://www.XYMed.com/cgi-bin/search?queryText=Thyroglobulin+Antibodies  
“http://www.XYMed.com/cgi-bin/search?queryText=Thyroglobulin+Antibodies+

In contrast, the first three quotes from Bessette do not describe selecting a set of **preexisting queries at a server** that correspond to received information about a medical procedure; but rather, a server that **receives a request that includes search parameters and performs a search on a database**; an NDMSR record that contains URLs that enable a client to link to remotely stored files; and, a medical facility archivist that modifies and updates an NDSMR. Clearly the second and third quotes are performed at the client and not at the server, as required by claim 1. Indeed, the first quote describes search parameters and performing a search on a database but nowhere does the first quote describe queries much less selecting a set of preexisting queries that correspond to received information about a medical procedure. Bessette therefore cannot be said to anticipate the above quoted limitations because Bessette, at best, discloses search parameters and searching an NDMSR database and claim 1 requires selecting a set of preexisting queries that correspond to received information about a medical procedure.

In summary, Bessette does not disclose each and every limitation of claim 1, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

Independent claims 38 and 46 include a limitation corresponding to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these independent claims. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining these other independent claims for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 6-7, 10-15, 17-20, 39-45, and 47 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

### **Response to Claim Rejections – 35 USC § 103**

Claims 2-5, 16, and 48-49 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over U.S. Patent No. 6,263,330 (hereinafter Bessette) in view of U.S. Patent No. 5,924,074 (hereinafter Evans).

Applicant respectfully submit that claims 2-5, 16, and 48-49 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Dependent claims 2-5, 16 and 48-49 depend upon independent claims 1 and 46, respectively. Independent claim 46 has been amended to include a limitation that corresponds to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these dependent claims.

In summary, Bessette in combination with Evans does not teach or suggest each and every limitation of claims 2-37 and 47-54 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

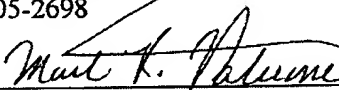
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21<sup>st</sup> day of April, 2005.

Dawn R. Shaw

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Signature

